

Serial No. 10/645,869
Amendment dated July 25, 2005
In Reply of Office Action dated March 24, 2005

REMARKS

The Office Action dated March 24, 2005 has been received and its contents carefully noted.

In view of the foregoing amendments, and following representations, reconsideration and allowance are respectfully requested.

Examiner Gilbert is thanked for the courtesies extended undersigned counsel during the telephone interview of July 22, 2005.

During that July 22, 2005 interview amended independent claim 1 was discussed, as well as new independent claim 17. The undersigned pointed out that the Baniel reference would have failed to teach Applicant's amended claim 1, for example, as Baniel et al. always left the Baniel et al. "constriction bands" in place.

Likewise, Applicant's representative pointed out the typographical error in the application, as filed, and indicated that the paragraph corrected above should have pointed out that the four disclosure documents had been attached to Applicant's earlier provisional application no. 60/404,933, filed August 22, 2002.

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In response, Examiner Gilbert accessed the electronic file wrapper of 60/404,933 and noted that the four disclosure document in the corresponding electronic file wrapper were present in the official Patent Office database. Thus, Applicant did not have to supply copies of such as had been requested in the Office Action.

No agreement as to allowability of the claims was reached.

Examiner Gilbert agreed that if the application were not allowable after studying the Amendment and the amended claims, then he would call the undersigned to resolve any remaining issues.

As to the Office Action in detail, please note the following.

As to the request for copies of the four disclosure documents in the first paragraph on page 2 of the Office Action, such is now moot, as Examiner Gilbert agreed in the July 22, 2004 telephone interview set forth above that electronic copies were available in the Patent Office files.

To overcome the rejection of claim 1 under 35 USC 112 second paragraph, claim 1 has been amended to change "for

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diagnosing" to --diagnosed with-- in the first two lines of claim 1, as filed, as discussed with Examiner Gilbert.

To overcome the rejection of the claims in view of the prior art under 35 USC 102(b) and 103, Applicant has amended independent claim 1 to still further define thereover.

Applicant has more particularly claimed the invention, including the method step of for example "the method being performed without the use of a constricting ring on the penis of the human male subject." Not only did Baniel et al. teach directly away from the claimed invention, as discussed during the July 22, 2005 interview, but would have failed to teach or suggest Applicant's overall invention. Specifically, on page 59, the left hand column, in the fourth full paragraph beginning "All patients first underwent treatment for ED with the [...]", Baniel et al. described in the middle of that paragraph how "When the patient reported pain, the cylinder was removed but the constriction bands were left in place for an additional 1-2 min." [emphasis added]. That methodology and teaching of Baniel et al. is directly contrary to Applicant's claimed method being performed without the use a constricting band, as set forth in independent claim 1.

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Applicant has provided support for Applicant's claimed method being performed without the use of a constricting ring in the application as filed. As requested by the Examiner, the attention of the Examiner is directed to page 12, lines 1-5, in which Applicant stated "All treatments of the present invention used the hand-held manual or battery-operated vacuum pump (with cylinder), alone or with medications. The constricting ring is not used."

As to the Section 103 restriction, in which U. S. Patent No. 6,087,362 to El-Rashidy was introduced as a modifying reference to show the use of a combination therapy with Baniel, such would have likewise failed to undo the defects of Baniel which would have taught a person having ordinary skill in the art at the time of the invention to use a constriction ring on the penis. El-Rashidy is silent as to the use of a vacuum pump, and is concerned with "psychogenic impotence". El-Rashidy clearly states in Col.1, lines 33-39:

As used herein, psychogenic impotence is defined as functional impotence with no apparent overwhelming organic basis. It may be characterized by an ability to have an erection in response to some stimuli (e.g., masturbation, spontaneous nocturnal, spontaneous early morning, video erotica, etc.) but not others (e.g., partner or spousal attention).

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Quite simply, El-Rashidy teaches away from the claimed use of "momentary vacuum therapy" or is silent at best. Thus, El-Rashidy would have failed to render obvious applicant's amended independent claim 1, whether or not El-Rashidy's disclosure would have addressed combination pharmacotherapies.

Still further, as to the claims regarding combination pharmacotherapies, as well as monotherapies, for example, the attention of the Examiner is directed to the Applicant's specification, as filed; i.e., please see the paragraph on page 22, lines 4-9, in which such is discussed.

To reduce the number of issues, claims 2, 3, 4, 6, 7, 8, 14, and 16 have been cancelled.

New claims 17 and 18 have been set forth to provide Applicant with the varied scope of protection to which he is entitled.

In sum, the application is submitted to be in condition for allowance with claims 1, 5, 9-13, 15, 17, and 18.

Claims 1 and 17 are in independent form.

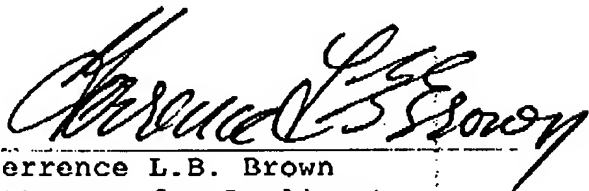
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Please charge Deposit Account No. 19-2105 the amount of \$60.00 for a one-month extension of time. It is believed that no additional fee is due. However, should that determination be incorrect, Examiner Gilbert is hereby authorized to charge any deficiencies to our Deposit Account No. 19-2105 and inform the undersigned in due course.

Should any outstanding formal matters or other issues remain, the Examiner is hereby requested to telephone Terrence Brown at 703-684-5600 to resolve such.

Respectfully submitted,

Date: July 25, 2005 By: 
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